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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,674	03/03/2004	Gina Parmar	016778-0474	2300
22428 7590 09/24/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER LE, DANH C	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 09/24/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,674

Applicant(s)

PARMAR ET AL.

Examiner

DANH C. LE

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 13, 15, 17, 18, 20, 21, 23, 24 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 13, 15, 17, 18, 20, 21, 23, 24, 26-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-4, 7, 8, 17, 20, 22, 23, 28, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi (US 6,377,804) in view of Ray (US 6,424,638).**

As to claim 1, Lintulampi teaches a method of establishing Universal Mobile Telecommunications System (UMTS) communication between User Equipment (UE) and a UMTS network (figure 4a, 5a), wherein the User Equipment is in communication with a Global System for Mobile communication (GSM)-type network (figure 4A-B and 5A-B), the method comprising:

forwarding UMTS Terrestrial Radio Access Network (UTRAN) parameter transparently to the User Equipment via the GSM-type network (figure 4a, UMTS-RAN sends A-HOack to MS or figure 5a, UMTS SGSN sends MM-RA-updateAccepted to the MS); and

in the User Equipment, interpreting the UTRAN parameters and initiating communication with the UMTS network.

Switching communication with the EU from the GSM-type network to the UMTS network.

Wherein the UTRAN parameters **forward to the UE (figure 4, step A-HOCommand, HO command, handover command send from UTM network to UE through GSM network)** comprises bit transmission rate, bit error rate and transmission delay to the UE.

Lintulampi fails to teach a list of at least one node. Ray teaches a list of at least one node (col.5, lines 32-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ray into the system of Lintulampi in order to provide a handover of a call between different types of a system as Ray suggested.

As to claim 2, Lintulampi teaches the method according to claim 1, wherein the UTRAN parameter supplied by a Radio Network Controller of the UMTS network (col.2, lines 37-49) and wherein the UTRAN parameters are directly forwarded to the UE from the GSM-type network as part of handover command, without passing through any other type of network **(figure 4, step A-HOCommand, HO command, handover command send from UTM network to UE through GSM network)**.

As to claim 3, Lintulampi teaches the method according to claim 1, wherein the UTRAN parameter comprises a list of potential UTRAN access points (col.2, lines 37-49).

As to claim 4, Lintulampi teaches a method according to claim 1, wherein the UE is arranged to establish a link through the Radio Network Controller (RNC) of the UMTS network to the MSC of the GSM-type network (table 5A and 5B, MM-RA-updated accepted path).

As to claim 7, the claim is a mean for function claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 8, Lintulampi teaches a message or data packet in a GSM-type network containing UTRAN parameters forwarded to UE for handing over a GSM call to a UMTS network to User Equipment engaged in a GSM call and capable of switching to a UMTS call (**forward to the UE, step A-HOCommand, HO command, handover command send from UTMS network to UE through GMS network**).

Handover the GSM call from the GSM type network to the UMTS network.

Lintulampi fails to teach a list of at least on potential node. Ray teaches a list of at least one potential node (col.5, lines 32-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ray into the system of Lintulampi in order to provide a handover of a call between different types of a system as Ray suggested.

As to claim 17, the claim is a system claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 20, the claim is an apparatus claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 23, Lintulampi teaches a Radio Network Controller (figure 2, elements 5, 7, figures 4, 5 and their descriptions), comprising:

means for generating the Universal Mobile Telecommunications System (UMTS) Terrestrial Radio Access Network (UTRAN) parameters;

means for forwarding the UTRAN parameters, via the Global System for Mobile communication (GSM)-type network, transparently to the User Equipment (UE) which communicates with the GSM-type network,

Switching communication with the UE from the GSM-type network to the UMTS network.

whereby the UE interpretes the UTRAN parameters **forward to the UE (figure 4, step A-HOCommand, HO command, handover command send from UTMS network to UE through GMS network)** and initiates communication with the UMTS network.

Lintulampi fails to teach a list of at least on potential node. Ray teaches a list of at least one potential node (col.5, lines 32-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ray into the system of Lintulampi in order to provide a handover of a call between different types of a system as Ray suggested.

AS to claim 28, the combination of Lintulampi and Ray teaches the method according to claim 1, wherein the UTRAN parameter information includes one or more of data rate, call type or quality service (transmission rate).

As to claim 32, the limitation of the claim is the same limitation of claim 28; therefore, the claim is interpreted and rejected as set forth as claim 28.

2. Claims 5 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi and Ray in view of Le (US 6,556,820).

As to claim 5, Lintulampi and Ray teaches a method according to claim 1, Lintulampi and Ray fails to teach the potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links. Le teaches the potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links (col.13. lines 2-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Le into the system of Lintulampi and Ray in order to update on a dynamic basis.

As to claim 30, the combination of Lintulampi and Ray and Le teaches further comprises the UTRAN parameter information output from the UMTS network tunnel through the GSM type network without being interpreted or processed in any matter by the GSM type network (Le, figure 8, 810) and Wherein the UTRAN parameters **forward to the UE (figure 4, step A-HOCommand, HO command, handover command send from UTMS network to UE through GMS network)** comprises bit transmission rate, bit error rate and transmission delay to the UE.

3. Claims 13, 15, 18, 21, 24, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi and Ray in view of Rinne (US 2001/0046863)

As to claim 13, Lintulampi and Ray teaches the method according to claim 1, Lintulampi and Ray fails to teach the parameters include one or more of Downlink (DL) channelization code, Uplink (UL) spreading factor, Uplink (UL) scrambling code, Radio Frequency, Radio Link ID, Link Reference, S-RNTI, Transport Format Sets, Transport Format Combination Set and Initial DL Power. Rinne teaches the parameters include

one or more of Downlink (DL) channelization code, Uplink (UL) spreading factor, Uplink (UL) scrambling code, Radio Frequency, Radio Link ID, Link Reference, S-RNTI, Transport Format Sets, Transport Format Combination Set and Initial DL Power (paragraph 195, 198). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rinne into the system of Lintulampi and Ray in order to enhance the system performance of the mobile communication system.

As to claim 15, the limitation of the claim is the same limitation of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 18, the claim is a system claim of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 21, the claim is an apparatus claim of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 24, the limitation of the claim is the same limitation of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 26, the limitation of the claim is the same limitation of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

4. Claims 27, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi (US 6,377,804) and Ray in view of Tiedemann (US 6,216,004).

As to claim 27, the combination of Lintulampi and Ray teaches the method according to claim 1, further comprising switching directly from a mode in which UE is in communication with a GSM base station to a UMTS mode which the UE is in

communication with a plurality of UTM access mode (figure 5, step MM-RA-update, the UE communicate with UMTS SGSN and step SENDER (session , sender_Tspec), UE communication with UMTS GGSN). The combination fails to teach a diversity mode in which the UE is in communication with a plurality of base station access nodes. Tiedemann teaches a diversity mode in which the UE is in communication with a plurality of base station access nodes (col.14, lines 50-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tiedemann into the system of Lintulampi and Ray in order to enhance the performance of the mobile communication system.

As to claim 31, the limitation of the claim is the same limitation of claim 27; therefore, the claim is interpreted and rejected as set forth as claim 27.

5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi (US 6,377,804) and Ray in view of Burns (US 7,200,110).

As to claim 29, the combination of Lintulampi and Ray teaches the method according to claim 1, which generating a list of one or more available links for the UE; Lintulampi and Ray fails to teach deleting, for the list of one or more available links, links on which satisfactory communication is not possible, to obtain an updated list of one or more available links; and supplying the updated list of one or more available links to the UE. Burns teaches deleting, for the list of one or more available links, links on which satisfactory communication is not possible, to obtain an updated list of one or more available links; and supplying the updated list of one or more available links to the UE (col.14, lines 44-55). Therefore, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to provide the teaching of Burns into the system of Lintulampi and Ray in order to enhance the performance of the mobile communication system.

Response to Arguments

2. Applicant's arguments filed on 5/30/08 have been fully considered but they are not persuasive.

On page 8, paragraphs 2 and 3 of the Applicant remarks, the Applicant argues that Ray does not disclose, teach or suggest that UTRAN parameters are forwarded to the UE, wherein those UTRAN parameters and the User Equipment (UE) of claim 1 is a device used by a User to make or answer a call, which is clearly not the case with Ray's Internet Gatekeeper 320, which is network device that is not accessed by a user to make or answer a call, as explicitly recited in independent claim 1.

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Lintulampi already taught these recited limitations wherein the UE is a mobile phone and UTRAN parameters are forward to the UE (see above recitation).

On page 9, paragraph 7 of the Applicant remarks, the Applicant argues that Le did not teach or suggest disclosure or suggestion that the UTRAN parameters comprise a list of at least one access node and a determination is used for deleting a link.

In response, the Examiner believes that the combination of Lintulampi and Ray teaches UTRAN parameters comprise a list of at least one access node, addition Lintulampi inherently teaches a determination is used for deleting a link on figure 3 step NO, select next PLMN in the list which deleting a link that was not selected.

On page 10, paragraph 4 of the Applicant remarks, the Applicant argues that Tiedemann did not teach or suggest switching from a non-diversity mode in a first network to a diversity mode in a second network different from the first network.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Lintulampi already taught these recited limitations in which the first network is a GSM network and a second network is UMTS network with a dual mobile modes which read on diversity mode and a plurality of UMTS access mode (see above recited limitations)

On page 10, paragraph 4 of the Applicant remarks, the Applicant argues that the GSM components do appear to interpreted signal sent between the MS and the UMTS network.

In response, the Examiner believes that the signal was not interpreted between the MS and the UMTS network on col.4, lines 27-29, **figure 4, step A-HOCommand, HO command, handover command send from UTMS network to UE through GMS**

network, Lintulampi did not show that the GSM interpreted signals by response handover request between networks.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C. LE whose telephone number is 571-272-7868. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DWAYNE D. BOST can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 16, 2008

/DANH C LE/
Primary Examiner, Art Unit 2617